



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/412,233	03/05/2012	David TROPP	5090-82769-A	8740

23432 7590 02/27/2015
COOPER & DUNHAM, LLP
30 Rockefeller Plaza
20th Floor
NEW YORK, NY 10112

EXAMINER

CASLER, TRACI

ART UNIT	PAPER NUMBER
----------	--------------

3629

MAIL DATE	DELIVERY MODE
-----------	---------------

02/27/2015

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 13/412,233	Applicant(s) TROPP, DAVID	
	Examiner TRACI CASLER	Art Unit 3629	AIA (First Inventor to File) Status No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/24/2014.
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

- 5) ☒ Claim(s) 29-53 is/are pending in the application.
5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 29-53 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

- a) ☐ All b) ☐ Some** c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 3) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)
Paper No(s)/Mail Date ____. | 4) <input type="checkbox"/> Other: ____. |

1. The present application is being examined under the pre-AIA first to invent provisions.

DETAILED ACTION

This action is in response to papers filed on 12/24/2014 and 01/09/2015.

No claims have been amended.

Claims 29-53 are pending.

Claims 29-53 are rejected.

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of 35 U.S.C. 112(a) or the first paragraph of pre-AIA 35 U.S.C. 112, except for the best mode requirement. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994)

The disclosure of the prior-filed application, Application No. 10/706500 (now Patent 7021537) fails to provide adequate support or enablement in the manner provided by 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph for one or more

Art Unit: 3629

claims of this application. The disclosure of '500 fails to recite Pg. 2 | 23-25 of the instant invention in which applicant discloses a definition of 'any special lock' and the definition directed to size and shape of the lock. This aspect of the instant invention first appears in applicants applicant 10/75631 (now patent 8145576) filed January 1, 2004. As such any claim limitation directed to a different 'look or size' or type of lock is only afforded the priority date of January 1, 2004. The examiner notes the limitations in question are of claims 29, 36, 42 and 49 which claim a first and second subset of locks. As well as claims 30 and 37 directed to a third subset of locks.

Claim Rejections - 35 USC § 112

2. Claims 29-53 are rejected under 35 U.S.C. 112(a) or 35 U.S.C. 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor or a joint inventor, or for pre-AIA the inventor(s), at the time the application was filed, had possession of the claimed invention.

3. Claims 29, 36, 42 and 49 are rejected as currently written as the disclosure fails to support applicant had possession of the claimed subject matter at the time of invention. Applicants claims are directed to a 'set of locks' that have a first and second subsets of combination locks and that all the locks in the set of locks with first and second subsets of combinations are opened with the SAME master key. The examiner notes as applicants disclosure is currently written the disclosure does not support that

applicant had possession of this aspect of the limitation at the time of invention. The disclosure states the master lock can opens any special lock of 'this type' this is understood by one skilled in the art to mean "this type" one type not multiple types. The types disclosed is only examples and directed to 'look' of the lock not the function of the actual locks themselves.

4. MPEP 2136.02 states

Whenever the issue arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Regents of the Univ. of Cal. v. Eli Lilly*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997); *Amgen, Inc. v. Chugai Pharm.*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991) (one must define a compound by "whatever characteristics sufficiently distinguish it").

The subject matter of the claim need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the description requirement. If a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application. This conclusion will result in the rejection of the claims affected under 35 U.S.C. 112(a) or pre-AIA 35 U.S.C.112, first paragraph - description requirement, or denial of the benefit of the filing date of a previously filed application, as appropriate

5. Determine whether the application as filed describes the complete structure (or acts of a process) of the claimed invention as a whole. The complete structure of a species or embodiment typically satisfies the requirement that the description be set forth “in such full, clear, concise, and exact terms” to show possession of the claimed invention. 35 U.S.C. 112, para. 1. Cf. Fields v. Conover, 443 F.2d 1386, 1392, 170 USPQ 276, 280 (CCPA 1971) (finding a lack of written description because the specification lacked the “full, clear, concise, and exact written description” which is necessary to support the claimed invention). If a complete structure is disclosed, the written description requirement is satisfied for that species or embodiment, and a rejection under 35 U.S.C. 112, para. 1, for lack of written description must not be made. Applicant fails to disclose structure of a ‘set of locks’ that contain a first and second subset of combination locks’ in clear and concise detail to support the claimed limitations.

6. If the application as filed does not disclose the complete structure (or acts of a process) of the claimed invention as a whole, determine whether the specification discloses other relevant identifying characteristics sufficient to describe the claimed invention in such full, clear, concise, and exact terms that a skilled artisan would recognize applicant was in possession of the claimed invention. For example, if the art has established a strong correlation between structure and function, one skilled in the art would be able to predict with a reasonable degree of confidence the structure of the claimed invention from a recitation of its function. Thus, the written description requirement may be satisfied through disclosure of function and minimal structure when

Art Unit: 3629

there is a well-established correlation between structure and function. In contrast, without such a correlation, the capability to recognize or understand the structure from the mere recitation of function and minimal structure is highly unlikely. Applicants disclosure simply states that 'any special types of lock having a 'multiplicity of subtypes such as "size designs and style" this does not lead one skilled in the art to understand this means different combinations; In this latter case, disclosure of function alone is little more than a wish for possession; it does not satisfy the written description requirement. See *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406 (written description requirement not satisfied by merely providing "a result that one might achieve if one made that invention"); *In re Wilder*, 736 F.2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (affirming a rejection for lack of written description because the specification does "little more than outline goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate"). Compare *Fonar*, 107 F.3d at 1549, 41 USPQ2d at 1805 (disclosure of software function adequate in that art).

7. As to claims 30 and 37 they are directed to a 'third subset' of locks that are rejected for the same reason as set forth above.

8. As to claims 21-35, 38-41, 43-48 and 50-53 the claims depend from the above rejected claims and as such are rejected set for above.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 3629

Claims 49-53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because the claim(s) as a whole, considering all claim elements both individually and in combination, do not amount to significantly more than an abstract idea. The claim(s) is/are directed to the abstract idea of managing luggage security (i) a fundamental economic practice, (ii) a method of organizing human activities, (iii) an idea of itself, or (iv) a mathematical relationship or formula. For instance, in Alice Corp. the court found that “intermediated settlement” was a fundamental economic practice, which is an abstract idea. Viewed as a whole, these additional claim element(s) do not provide meaningful limitation(s) to transform the abstract idea into a patent eligible application of the abstract idea such that the claim(s) amounts to significantly more than the abstract idea itself. Therefore, the claim(s) are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

10. In the event the determination of the status of the application as subject to AIA 35 U.S.C. 102 and 103 (or as subject to pre-AIA 35 U.S.C. 102 and 103) is incorrect, any correction of the statutory basis for the rejection will not be considered a new ground of rejection if the prior art relied upon, and the rationale supporting the rejection, would be the same under either status.

11. The following is a quotation of pre-AIA 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

Art Unit: 3629

said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 29-53 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Masterlock in view of US Pat 6877345 Misner et al; Combination and Key operated padlock with indicator in further view of NPL "Getting back to the business: An update on the Travel Sentry Project" Travel Goods Showcase Magazine July/August 2003. Hereinafter referred to as Masterlock, Misner and Travel Goods respectively.

13. As to claims 29, 36, 42 and 49 Masterlock teaches a set of locks and method for using the set of locks as:

14. the master key portion of each lock in the first and second subsets of locks is configured for the same master key to unlock and re-lock the lock for the authorized luggage-screening independently of a locked state of the combination lock portion of the same lock; the combination lock portion of each lock in the first and second subsets of locks is configured to unlock and re-lock the lock independently of a locked state of the master key portion of the same lock,

15. **(Masterlock Pg 20 Master Keyed in which multiple locks have their own individual key to unlock as well as can be unlocked by 'master key'. See also Pg. 3 1500 series for combination locks that each have their own combination and opened by a master key)**

16. using respective different combination dial settings of the plural number of dials as selected by of for the travelers; Additionally Misner teaches Travel Sentry system in which government officials have an 'override key' that is used for opening combination operated luggage padlocks that are made by a number of manufacturers.

Art Unit: 3629

17. each lock of a first subset of plural locks and a second subset of plural locks of the locks in the set has two or more combination lock dials; See Misner Fig 1 as a 'combination lock dials as well as Travel Goods Pgs 1 of plural locks one containing at least 2 dials).

18. the number of dials in each lock of the first subset differs from the number of dials in each lock of the second subset; and (**Masterbuilt teaches a variety of locks with different dials Pg. 25)**

19. each lock in the set has the same prominent indicia configured to uniquely differentiate the locks of the set from locks that are not configured for the luggage-screening entity to unlock and re-lock with the same master key for said authorized luggage-screening by said entity, (Travel goods teaches an indicia on all the locks See pictures of all locks as well as accompanying description which discusses TravelSentry "certifying Mark").

20. It would have been obvious to one skilled in the art at the time of invention to combine the combination locks of Masterbuild and TravelSentry with Misners 'override' key as one skilled in the art would have been motivated to make the combination as shown by the fact that all references are directed to solving the same problem in the art as noted by Misner in C. 1 I. 30-41 and Travel goods Pg. 1 first paragraph, stating that TSA will not break locks in order to inspect luggage when travels lock their bags and ordering travelers to not lock luggage if they don't want their locks broken.

21. As to claims 30 and 37 See Travel Good Pg. 2 figures of different locks other than combination locks.

Art Unit: 3629

22. As to claims 31 and 43 Masterlock shows combination locks with 3 and 4 dials however Pg. 25-27 See also Misner C. 12 I. 40-45. It would have been obvious to one skilled in the art at the time of invention to combine the combination locks of Masterbuild and TravelSentry with Misners 'override' key as one skilled in the art would have been motivated to make the combination as shown by the fact that all references are directed to solving the same problem in the art as noted by Misner in C. 1 I. 30-41 and Travel goods Pg. 1 first paragraph, stating that TSA will not break locks in order to inspect luggage when travels lock their bags and ordering travelers to not lock luggage if they don't want their locks broken.

23.

24. As to claims 32 and 44 See Master lock Pg. 20 showing key hole on bottom.

25. As to claims 33, 38-40, 48 and 52-53 See Travel goods discussing the project in combination with TSA. It would have been obvious to one skilled in the art at the time of invention to combine the combination locks of Masterbuild and TravelSentry with Misners 'override' key as one skilled in the art would have been motivated to make the combination as shown by the fact that all references are directed to solving the same problem in the art as noted by Misner in C. 1 I. 30-41 and Travel goods Pg. 1 first paragraph, stating that TSA will not break locks in order to inspect luggage when travels lock their bags and ordering travelers to not lock luggage if they don't want their locks broken.

26. As to claims 34, 41 and 47 See Master Lock Pg. 17

Art Unit: 3629

27. As to 35 and 45 all of Master lock discussing all different pad locks and figures/pictures

28. As to claim 46 See Misner Fig 1 Fef. 350 and C. 1 l. 45-46 over ride keys. It would have been obvious to one skilled in the art at the time of invention to combine the combination locks of Masterbuild and TravelSentry with Misners 'override' key as one skilled in the art would have been motivated to make the combination as shown by the fact that all references are directed to solving the same problem in the art as noted by Misner in C. 1 l. 30-41 and Travel goods Pg. 1 first paragraph, stating that TSA will not break locks in order to inspect luggage when travels lock their bags and ordering travelers to not lock luggage if they don't want their locks broken.

29. As to claim 50 See Misner C. 2 l. 23-28. It would have been obvious to one skilled in the art at the time of invention to combine the combination locks of Masterbuild and TravelSentry with Misners 'override' key as one skilled in the art would have been motivated to make the combination as shown by the fact that all references are directed to solving the same problem in the art as noted by Misner in C. 1 l. 30-41 and Travel goods Pg. 1 first paragraph, stating that TSA will not break locks in order to inspect luggage when travels lock their bags and ordering travelers to not lock luggage if they don't want their locks broken.

30. As to claim 51 See Misner figure 1 and C. 12 l. 40-45. It would have been obvious to one skilled in the art at the time of invention to combine the combination locks of Masterbuild and TravelSentry with Misners 'override' key as one skilled in the art would have been motivated to make the combination as shown by the fact that all

Art Unit: 3629

references are directed to solving the same problem in the art as noted by Misner in C.

1 I. 30-41 and Travel goods Pg. 1 first paragraph, stating that TSA will not break locks in order to inspect luggage when travelers lock their bags and ordering travelers to not lock luggage if they don't want their locks broken.

Double Patenting

31. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

32. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

Art Unit: 3629

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

33. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

34. Claims 29-53 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 7,021,537 and over claims 1-6 of U.S. Patent No. 8,145,576. Although the conflicting claims are not identical, they are not patentably distinct from each other as shown below: it would have been obvious to one of ordinary skill in the art to have the locks in question that are used in the above noted method claims.

35. Claims 29-53 provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-30 of copending Application No. 13744261. Although the claims at issue are not identical, they are not patentably distinct from each other because: The examiner notes applicant is referred to the previous rejection containing the double patenting matter

This is a provisional nonstatutory double patenting rejection because the patentably indistinct claims have not in fact been patented.

Response to Arguments

36. The examiner notes applicants have filed numerous affidavits/declarations in response to the non-final rejection of the instant application mailed 09/24/2014. The affidavits were to establish conception and diligence of applicants invention prior to the prior art of record as well as showing of possession of the claimed invention in response to the 112 1st Lack of written description rejection in which applicants failed to show possession of the claimed invention and the priority date of the claimed invention. The examiner notes as is shown in the MPEP the items to know when swearing behind must

1. Establish conception of the CLAIMED invention as well as show due diligence to the reduction to practice. And that critical period for diligence for a first conceiver but second reducer begins not at the time of conception of the first conceiver but just prior to the entry in the field of the party who was first to reduce to practice and continues until the first conceiver reduces to practice. The examiner notes the date of reduction to practice for the record is being deemed a constructive reduction to practice as the filing the first application 10/706500 filed November 12, 2003 and January 1, 2004 for the limitation of *wherein the same master key unlocks the master key portion of each lock in the first and second subsets, and different locks of the first and second subsets have combination lock portions with different plural numbers of dials*, and each lock in the set has the same prominent indicia configured to uniquely differentiate the locks of the set from locks that are *not configured for the luggage-screening entity to unlock and re-lock with the same master key for said authorized luggage-screening by said entity.*

Art Unit: 3629

37. The examiner notes applicants affidavits filed 12/24/2014 submitted by Al Smaldone, Katherine Fowler and Tommy Memelshtyan are found not persuasive as to the actual reduction to practice. The examiner notes applicants the affidavits are not directed to the claimed invention as a whole, the affidavits are merely general statements of Mr. Tropp sharing an idea regarding supplying TSA with a locks and master keys for baggage inspection. The affidavits fail to address the specifics of the claimed limitations in question such as one single master key being utilized to open all keys with in set of specialized locks that include subsets with different numbers of dials for combination lock portion. As such the affidavits have been entered into the record but as such are not persuasive to an actual/constructive reduction to practice of the claimed invention

38. As to applicants affidavit submitted by named inventor David Tropp on December 24, 2014 which consists of Table 1 and Table 2 to summarize and support applicants efforts regarding diligence for reduction to practice. The examiner notes the first paragraph of the applicant's declaration states that the supported documentation the applicant uses the terminology "My invention" to show he is the inventor of the claimed invention. However, applicant is reminded It is settled that in establishing conception a party must show possession of every feature recited in the claim, and that every limitation of the claim must have been known to the inventor at the time of the alleged conception. Conception must be proved by corroborating evidence.); Hybritech Inc. v. Monoclonal Antibodies Inc., 802 F. 2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986) Inventor's "hope" that a the conceived idea would produce an complete and operative

Art Unit: 3629

invention to be applied in practice as shown in the documents from Dec. 19, 2002 does not establish conception, since the inventor did not show that he had a "definite and permanent understanding" as to whether or how, or a reasonable expectation that, the special lock would solve be applied in practice. As to applicants belief that 'conception' of the claimed invention is supported based on documents submitted by applicants 'brainstorming' and notes from December 19, 2002 the examiner notes applicant fails to show possession of the claimed subject matter of the instant invention as of December 19, 2002. . Applicants affidavit/declaration talks in generalities about locks and combinations but speaking about the "THE liberty lock" or "the special lock" that can be opened it simply talks in the singular of the lock not in the claimed terminology of multiple lock combinations being opened by only one type of master key. Applicant also points to the proposal submitted to the TSA for consideration of providing the TSA with a system of locks" all of which have a master key portion. The examiner notes the proposal to the TSA again addresses the lock as 'the lock'/the special lock in the singular from the proposal does not support either possession or conception of the claimed invention in which "the master key" is used to open multiple subsets of combination locks. As such the applicants affidavit/declaration is not persuasive in showing applicant had possession of the CLAIMED invention as of the date of conception. The examiner additionally notes applicants 'conception' of the limitations regarding limitation of *wherein the same master key unlocks the master key portion of each lock in the first and second subsets, and different locks of the first and second subsets have combination lock portions with different plural numbers of dials*, is given

Art Unit: 3629

the date of conception as of the date of the filing of the second application on January 1, 2004. There is no evidence supporting this limitation prior to the filing of the continuation in part in which the section that discusses opening any special lock of this type" and the definition of the phrase "any special lock of this type" was new matter in the CIP which was not present in the parent application. The examiner notes conception of the claimed invention must be established the affidavit or declaration showing must still establish possession of the invention affidavit must show possession of either the whole invention as claimed or something falling within the claim(s) such as a species of the claimed genus prior to the effective date of the reference being antedated; it is not enough merely to show possession of what the reference happens to show if the reference does not teach the basic inventive concept. However, Applicant rather is claiming the 'species' when only showing a generic concept not the narrow species of which is claimed.

39. As to the showing of due diligence, the examiner first notes that in order for there to be a need to determine diligence possession has to be show. In determining the sufficiency of a **37 CFR 1.131(a)** affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, pursuant to **37 CFR 1.131(b)**, diligence comes into question only after prior conception is established. As such diligence is a moot point. However, for the sake of advancing prosecution the examiner will address diligence. The examiner notes applicant is diligence in showing reduction to practice has gaps of time in which there is no work being accounted for such as from the time applicant conceived the generic

Art Unit: 3629

concept there is no showing of reduction to practice of the claimed invention as a continuous effort. In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; of which applicant has not given an explanation for inactivity. The examiner notes . Applicant submitted a proposal to TSA but shows no other action for moving forward with developing the nuts and bolts of the claimed invention until possibly July when it is alleged discussions to manufacturing of "the lock"; the examiner notes efforts to exploit an invention commercially(i.e. through an exclusive agreement with TSA) do not constitute diligence in reducing it to practice. The examiner notes there is a lack of evidence provided to create a factual record showing any work was being done fails to adequately show diligence to reduction to practice. Applicant generally states that between the time of March 28, 2003 and September 30, 2003 the applicant spends at least 50 hours researching/testing implementing his invention. Again, these are general statements, the examiner notes it seems unlikely there are no notes or documentation to support the research. The courts have found that even a 2 day period lacking activity can be fatal . In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); Kendall v. Searles, 173

Art Unit: 3629

F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.). As there are gaps in the timing of diligence particularly leading up to the effective date of the prior art of record (Travel Sentry article supporting development of the method dated July/Aug 2003 as well as Misner Patent filed on Aug. 3, 2003 applicant does not appear to be seeking legal assistance until after these dates. If applicant purportedly had possession of the conceived idea when the TSA proposal was submitted there was nothing preventing applicant to seek patent counsel at such a time. It appears that applicant began to seek patent counsel after publication of the Travel Sentry article and filing of the Misner patent after reading the article on August 20, 2003 discussing TSA's agreement with another organization.

40. As to applicant's arguments regarding affidavit submitted by Renny Tse-Haw Ling as the examiner is not persuaded by the declaration for various reasons. 1. The affidavit first address the 'non-obviousness of the invention based on the prior art rejection; however, this affidavit (as noted previously) address in correct rejections Pg. 2 item 9; these rejections are not longer the outstanding rejection as such statements directed to the rejection of the claimed invention are moot. As to Renny Tse-Haw Ling's 3rd declaration in which Renny Tse-Haw Ling charts claim language to support applicants possession of the claimed invention based on Patent '537. The examiner notes the limitations in question are "where in the same master key unlocks the master key portion of each lock in the first and second subsets" and "Wherein the master key portion of each lock in the first and second subset of locks is configured for the same master key to unlock and re-lock..." The examiner note the declaration points to parent

Art Unit: 3629

case (Patent number 7021537) for support in case Generally to Fig 1-4 (all the drawings) as well as C. 4 I. 9-10 to support the master key for the first and second subset of locks. And C. 3 I. 64-66 "The master key portion for receiving a master key that can open the masker key portion of any special lock of this type". Declarant makes the statement that "any special lock" is identified as having a combination portion and a master key portion and again references the drawings. However, the examiner notes the "any special lock of this type" is not defined". Applicants brief description of claims states that each drawing is it's own embodiment. Therefore as understood in patent law different embodiments are just that different and distinct, the disclosed invention does not state there is a master key for each embodiment. As such 'any special key of this type' would be read by one skilled in the art as a type that has one master lock and a specific combination lock shown in each embodiment. Further more to accentuate the distinction between the "special lock" of paten '537 applicant filed a CIP(Patent number 8145576 '576) which by the nature of patent law indicates there is new matter entered that was not presented in the parent applicant and as such is only afforded the filing date of the CIP. The citations in which the declarant points to as teaching the equivalent of the limitations in question are distinctly different. In CIP '576 applicants new matter is in the definition of "any special lock of this type". This definition narrows the understanding of what is deemed 'any special lock'. As such is not equivalent to the cited portions of '537. Additionally, applicants disclosure fails to support how one would make 'any special lock of this type' having a multiplicity of sub-types such as different sizes, designs and styles."

Art Unit: 3629

41. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

42. As to applicants arguments regarding priority of the claimed subject matter the examiner notes this issue has been addressed above in addressing the affidavits. As to applicants arguments regarding being 'sufficient' to make and or use the invention the examiner notes 'enablement' is not in question but rather 'possession' of the claimed invention. While pertinent technology may be known to create the claimed invention the applicant must show they had possession of the invention at the time of filing. The test for possession is different than the test for enablement. The applicant argues while the words "set" and/or "subset" are not literally disclosed they are essentially implied. The examiner disagrees with this statement and as stated above applicants brief description of claims states that each drawing is its own embodiment. Therefore as understood in patent law different embodiments are just that different and distinct, the disclosed invention does not state there is a master key for each embodiment. As such 'any special key of this type' would be read by one skilled in the art as a type that has one master lock and a specific combination lock shown in each embodiment. One skilled in the art would not ready "any special key of this type" to include locks with different combination subsets that are opened by the same master key as filed in '537. As applicants declarant is pointing to distinctly worded support for the claimed limitations this draws into question what applicant possessed as their invention at the time of disclosure filing. The examiner notes applicants have failed to show that what is

Art Unit: 3629

conventional or known in the art is to have subset of locks defined together as 'a special lock to be opened by one single master key for both the subsets.

43. As to applicants arguments that the references fail to teach the claimed limitation.

The examiner notes that the references fail to be solving the same problem of "how to enable a luggage screening entity to efficiently open millions of pieces of luggage without breaking the many different locks that travelers chose and still leave the luggage secured with operating locks for the rest of the trip." The examiner notes that both the Misner and the Travel Goods article are directed to specifically solving this problem.

While master lock may not be directed to solving the problem it is deemed analogous art in that it is directed towards locks and use of locks for gaining access to locked items with key control for supervisory access. The examiner notes Masterlock is being depended upon for the teaching of padlock/combination lock knowledge and rekeying abilities. Applicant argues that 'single-dial locks are bulky and not suitable for airline luggage and as such would not motivate one skilled to make the combination. The examiner respectfully disagrees. As applicant has not claimed a specific "size" of the lock but rather a lock that secures the luggage than the single dial lock would be suitable. Additionally, applicant is reminded one of their drawing embodiments shows a single dial padlock as well as claim 30 which claims a lock mechanism other than the combination lock. As a single dial lock mechanism has been around for decades it would have been obvious to make this combination. In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or

Art Unit: 3629

modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007).

44. As to applicants arguments regarding rejections of claims 49-53 under 35 USC 101 the applicant argues the claims are not directed to an abstract idea as they incorporate physical components of each lock; thereby arriving at a new operation of such locks. The examiner notes the applicants are not claiming the operation of the locks but rather the use of the locks. The claimed invention is a method organizing human activity according to rules/policy and guidelines the locks are insignificant in the act but rather it is the TSA employees performing the screening.

45. As to applicants arguments regarding commercial success Objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971) (evidence showing commercial success of thermoplastic foam "cups" used in vending machines was not commensurate in scope with claims directed to thermoplastic foam "containers" broadly). In order to be commensurate in scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features. *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 229, 17 USPQ2d 1257, 1260 (D.D.C. 1990), *aff'd*, 959 F.2d 226, 228, 22 USPQ2d 1153, 1156 (Fed. Cir. 1992) (Features

Art Unit: 3629

responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue. Applicant has not submitted any evidence as to commercial success but rather general statements. An affidavit or declaration attributing commercial success to a product or process "constructed according to the disclosure and claims of [the] patent application" or other equivalent language does not establish a nexus between the claimed invention and the commercial success because there is no evidence that the product or process which has been sold corresponds to the claimed invention, or that whatever commercial success may have occurred is attributable to the product or process defined by the claims. where the commercially successful product or process is not coextensive with the claimed invention, applicant must show a legally sufficient relationship between the claimed feature and the commercial product or process. *Ex parte Standish*, 10 USPQ2d 1454, 1458 (Bd. Pat. App. & Inter. 1988).

46. As to the rejection of double patenting, applicant is silent with regard to this rejection as which the examiner takes as admission that the rejection is proper as such the rejection stands and applicant still needs to file a terminal disclaimer to obviate the rejection.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRACI CASLER whose telephone number is (571)272-6809. The examiner can normally be reached on Monday-Thursday 5:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on 571-272-6782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Traci L Casler
Primary Examiner
Art Unit 3629

/TRACI CASLER/
Primary Examiner, Art Unit 3629